

App. No. 09/618,321
Response to Office Action

Docket No. 66182

REMARKS

Reconsideration of the present application in view of the following remarks is respectfully requested. Twenty-two claims are pending in the application: Claims 1 through 22.

Examiner Telephone Interview

Applicant appreciates and thanks the Examiner for taking the time to discuss this application with Applicant's representative Richard E. Wawrzyniak on April 16, 2003. The below remarks summarize the points made during the telephone interview.

Claim Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,848,399 to Burke ("Burke") in view of U.S. Patent No. 5,237,157 to Kaplan ("Kaplan"). Applicant respectfully traverses this rejection.

Applicant's independent claim 1 recites "retrieving personalization data for a particular user from a database" and "the display area including images of one or more products that are selected based on the personalization data". Applicant's independent claim 12 recites similar language. Applicant submits that the rejections of claims 1 and 12 should be withdrawn because (i) Kaplan does not disclose or suggest these claim limitations; and (ii) a *prima facie* case of obviousness has not been established because Burke cannot be properly combined with Kaplan.

(i) Kaplan does not disclose or suggest the above recited claim limitations.

In the most recent office action the Examiner relies on Kaplan as allegedly teaching Applicant's claimed personalization data. Specifically, at the bottom of page 4 of the office action the Examiner points to Kaplan's discussion of profile data.

App. No. 09/618,321
Response to Office Action

Docket No. 66182

However, Applicant can find nothing in Kaplan that discloses that images of one or more products are selected based on the profile data for a particular user.

For example, the Examiner cites Kaplan's Abstract, which states the following:

"Subscriber selection and profile data are collected and stored. The invention also provides for transmission of subscriber selection and subscriber profile data to a central database for collection and processing by the central processing unit." (Kaplan, Abstract, lines 8-12).

This language simply does not disclose that images of one or more products are selected based on the profile data for a particular user. The Examiner also cites Kaplan's column 3, lines 39-46, which states the following:

"The selection and input data from the subscriber is collected from each kiosk location and is transmitted to be stored in a central database for analysis by the central processing unit. Through the central processing unit, the subscriber selection and subscriber profile data can be analyzed, packaged, and distributed as information products to the entire music industry as timely and focused market research." (Kaplan, col. 3, lines 39-46).

Again, this language simply does not disclose that images of one or more products are selected based on the profile data for a particular user. Instead, the language states that the profile data can be analyzed, packaged, and distributed as timely and focused market research.

Therefore, the rejections of Applicant's claims 1 and 12 should be withdrawn because Kaplan does not disclose the display area including "images of one or more products that are selected based on the personalization data" for a particular user, as is recited in claim 1.

(ii) A prima facie case of obviousness has not been established.

Applicant submits that Burke cannot be properly combined with Kaplan. Specifically, in making the rejection the Examiner is presumably proposing that Burke

App. No. 09/618,321
Response to Office Action

Docket No. 66182

be modified according to the alleged personalization teachings of Kaplan in order to correspond to the above-recited limitations of claim 1. However, section 2143.01 of the MPEP states:

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).”

MPEP § 2143.01 Suggestion or Motivation To Modify the References.

Modifying Burke to use personalization data as recited in Applicant's claim 1 would destroy the intended function of Burke. This is because Burke's intended function is to display what a consumer would actually view in a real store. Namely, Burke teaches that the consumer is allowed to select a product category. (Burke, col. 7, lines 52-67). Burke states that “[t]he displayed product category appears to be very similar to what a consumer would actually view in a real store, such as shown in FIG. 14.” (Burke, col. 8, lines 2-4) (emphasis added). Any attempted modification to Burke's system to somehow make it display products based on a particular user's personalization data would destroy Burke's intended function of displaying what a consumer would actually view in a real store, which means that a person of ordinary skill in the art would not be motivated to make such modification. Therefore, Burke cannot be used to establish a *prima facie* case of obviousness of Applicant's claims 1 and 12 and the rejections should be withdrawn.

Furthermore, Burke teaches that “the research database 67 tracks consumer's actions in a manner which is transparent to the consumer.” (Burke, col. 6, lines 59-61). This also teaches away from the invention as claimed by Applicant. Namely, Applicant uses “personalization data” to select specific images that will be sent to the consumer, which means the consumer directly views an image which is the result of the system using the personalization data. Any attempted modification to Burke's system to somehow make it display products based on a particular user's personalization data would destroy Burke's intended function of transparently tracking

App. No. 09/618,321
Response to Office Action

Docket No. 66182

a consumer's actions because such modification will cause the consumer to view and experience the results of the tracking. This is another reason why it would not be obvious to modify Burke in order to achieve the invention claimed by Applicant.

Next, section 2143 of the MPEP states:

"To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

MPEP § 2143 Basic Requirements of a *Prima Facie* Case of Obviousness.

There is no motivation in Burke to be modified in the manner proposed by the Examiner because Burke actually teaches away from the selection of products being based on a particular user's personalization data. Namely, Burke's aim of displaying what a consumer would actually view in a real store teaches directly against Applicant's personalized shopping experience where the selection of displayed products is based on a particular user's personalization data.

Therefore, Applicant submits that the rejection based on Burke in view of Kaplan has been overcome and that the rejection of independent claim 1, as well as all of its respective dependent claims, should be withdrawn. The rejection of independent claim 12, as well as its respective dependent claims, should also be withdrawn for the same reasons.

With respect to Applicant's dependent claims 6 and 17, the Examiner asserts that Burke's column 9, lines 13-29 teach processing data included in the communication with an engine. Applicant respectfully disagrees and submits that there is no teaching of processing with a personalization engine in this portion of Burke.

No Fee Believed to be Due

No fee is required for the filing of this amendment.

App. No. 09/618,321
Response to Office Action

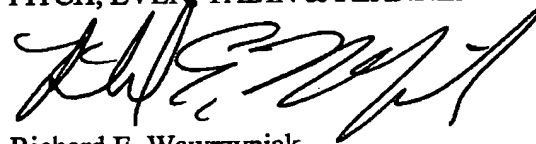
Docket No. 66182

CONCLUSION

In view of the above, Applicants submit that the pending claims are in condition for allowance, and prompt and favorable action is earnestly solicited. Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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4/22/03

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